

PATENT  
Docket No. 56077US002  
(formerly 56077USA7A.002)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): C. V. ANDERSON et al. )  
Serial No.: 09/759,993 )  
Confirmation No.: 1053 )  
Filed: 12 January 2001 )  
For: ADHESIVE FILM REMOVAL METHOD AND APPARATUS )

Group Art Unit: 1734  
Examiner: Mark A. Osele

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**REPLY BRIEF TO SUPPLEMENTAL EXAMINER'S ANSWER**

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellants request that this appeal be maintained in response to the Supplemental Examiner's Answer dated 10 April 2006 and file this Reply Brief in support of Appellants' positions. Appellants furthermore incorporate by reference herein the Appeal Brief filed 28 August 2003 and Appellant's Reply Brief filed 26 November 2003.

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### **III. STATUS OF CLAIMS**

Claims 1, 4-13, and 17-25 are pending in this application.

Claims 1, 4, 5, 8-13, 17, 18, and 21-25 are rejected and are the subject of this appeal.

Claims 6, 7, 19, and 20 are objected to as being dependent on a rejected base claim, but allowable if rewritten in independent form including all of the limitations of their respective base claims and any intervening claims. Claims 6, 7, 19, and 20 are not the subject of this appeal.

Claims 2, 3, and 14-16 were canceled during prosecution of this application.

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**II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.**

A. Claims 1, 4, 8-13, 17, 21, 22, and 25 stand rejected under 35 U.S.C. § 102(b) in view of French Patent Publication 2643487 to Apollonio et al.

B. Claims 1, 5, 8-10, 12, 18, and 22 stand rejected under 35 U.S.C. § 102(b) in view of U.S. Patent No. 5,891,298 to Kuroda et al.

C. Claim 24 stands rejected under 35 U.S.C. § 103(a) as patentable over French Patent Publication 2643487 to Apollonio et al.

D. Claim 23 stands rejected under 35 U.S.C. § 103(a) as patentable over French Patent Publication 2643487 to Apollonio et al. in view of U.S. Patent No. 5,891,297 to Stadtmueller. This is a new ground of rejection.

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### **III. ARGUMENT**

**A. Claims 1, 4, 8-13, 17, 21, 22, and 25 are patentable over French Patent Publication No. 2643847 to Apollonio et al. under 35 U.S.C. § 102(b).**

Appellants positions with respect to this rejection have been set forth previously in both the Appeal Brief filed August 28, 2003 and the Reply Brief filed November 26, 2003. This Reply Brief addresses the rejection as further discussed in the Supplemental Examiner's Answer.

In further support of this rejection, it is asserted by the Examiner that Apollonio et al. teaches "transferring the tension onto the substrate through a compressive roller, 34...." *Supplemental Examiner's Answer*, p. 3. Appellants traverse this assertion for at least the following reasons.

Figure 3 of Apollonio et al. and the first paragraph on page 5 of the English translation of Apollonio et al. are cited as support for the above-quoted assertion. Appellants submit that the cited portions of Apollonio et al. do not support the assertion. The cited paragraph is reproduced below for the convenience of the Board:

The reel 22 is charged and positioned on carriage 3. The installation begins with one from the ends from the billboard and finishes with the other. Strip (band) 32 of the old poster is removed automatically during the rise of carriage 3 and, at once, is rolled up on the reel tractor by slip 24. Strip 25 of the new adhesive poster, resulting from reel 22 is separated from the protective film 26 that is rolled up on the reel tractor with slip 23, progressively with the installation of band 25 which is pressed on the face of the turning prism 20 by means of rollers 34.

*Apollonio et al. Translation*, p. 5, ¶ 1.

Appellants note that the cited portion of Apollonio et al. (taken alone or in combination with Figure 3) does not teach "transferring the tension onto the substrate through a compressive roller, 34" as asserted. In fact, Apollonio et al. does not discuss any transfer of the tension forces generated by film removal using reel 24.

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In further support of this rejection, it is asserted, in the "Response to Argument" section of the Supplemental Examiner's Answer that "[t]he tension of film, 32, winding on spaced apart reel, 24, will pivot the framework of Apollonio et al. pressing the rollers, 34, against the surface of the structure thereby transferring the tension from the film onto the structure itself...."

*Supplemental Examiner's Answer*, pp. 6-7 (emphasis added). Appellants disagree.

As discussed in detail in Appellant's Reply Brief, Apollonio et al. simply does not support the Examiner's assertions as to how the compression forces generated by rollers are developed. Apollonio et al. does not discuss transfer any forces generated by film removal to the rollers 34. As a result, the assertions presented in support of this rejection are mere conjecture.

The Supplemental Examiner's Answer also fails to provide a reasoned technical analysis that would support an anticipation rejection based on inherency. Rather, it provides only additional conclusory statements in support of the rejection that attempt to characterize Apollonio et al. in a manner that is not supported by the document itself. For example, in the "Response to Argument" section of the Supplemental Examiner's Answer it is asserted that "[f]ramework of Apollonio et al. pivotally connects the winding reel, 24, with rollers, 34, which ride along the surface of structure, 20." *Supplemental Examiner's Answer*, p. 6. Appellants disagree.

Apollonio et al. do not teach that the frame extending between reel 24 and rollers 34 pivots about any axis. Furthermore, as noted previously by Appellants in the Reply Brief, the framework connecting the reel 24 and rollers 34 cannot pivot about any axis located within the framework itself because rollers 6 & 7 bear on opposite sides of the pole 1. As a result, the assertion regarding pivotal movement of the framework is not supported by the reference itself nor is the assertion supported by technical reasoning capable of supporting an anticipation rejection based on inherency.

In the end, this rejection fails to meet the requirements set for every anticipation rejection based on inherency, i.e., "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."

*M.P.E.P.* § 2112, p. 2100-57, 8<sup>th</sup> Ed., Rev. 3, (August 2005) (emphasis in original) (citing *In re*

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*Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In view of the above, Appellants submit that the Office has not met its burden in establishing inherency of the subject matter recited in claims 1, 4, 8-13, 17, 21, 22, and 25. Review and reversal of this anticipation rejection by the Board are, therefore, respectfully requested.

**B. Claims 1, 5, 8-10, 12, 18, and 22 are patentable over U.S. Patent No. 5,891,298 to Kuroda et al. under 35 U.S.C. § 102(b).**

Appellants positions with respect to this rejection have been set forth previously in both the Appeal Brief filed August 28, 2003 and the Reply Brief filed November 26, 2003. This Reply Brief addresses the rejection as further discussed in the Supplemental Examiner's Answer.

In further support of this rejection, it is asserted by the Examiner that Kuroda et al. teaches "transferring the tension onto the substrate through a compressive roller, 8...." *Supplemental Examiner's Answer*, p. 4. Appellants traverse this assertion for at least the following reasons.

First, Appellants note that no portion of Kuroda et al. is cited as support for the basic assertions made with respect to the rejection of independent claims 1, 12 & 22. Although a number of dependent claims are addressed individually, many of the assertions presented are also unsupported by any reference to the teachings of Kuroda et al. The assertions made in support of the rejection of claims 5 & 18 are accompanied only by a citation to Figure 8 of Kuroda et al. while the assertions made in support of the rejection of claim 10 are accompanied only by a citation to Figure 13.

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In the "Response to Argument" section, Appellants do note that it is asserted that "[i]nspection of Fig. 8 of Kuroda et al. shows analogous structures to Fig. 4 of the instant invention." *Supplemental Examiner's Answer*, p. 7. Specifically, it is asserted that the "[f]ramework of Kuroda et al. pivotally connects the winding reel, 18, with rollers, 8, which rides along the surface of the structure, W." *Id.* "The tension of film, 3, winding on spaced apart reel, 18, will pivot the framework of Kuroda et al. pressing the rollers, 8, against the surface of the structure thereby transferring the tension from the film onto the structure itself." *Id.* Although these assertions are presented with a discussion of the apparatus depicted in Figure 4 of the Appellants' application, the assertions with respect to operation of the apparatus of Kuroda et al. are still mere conjecture – unsupported by any teachings in Kuroda et al.

Appellants submit that, like the previous rejection under Apollonio et al., the Examiner has failed to identify, explicitly or inherently, the elements of the claimed inventions. For example, there is no teaching identified that the apparatus of Kuroda et al. transfers tension from the film to the workpiece. Rather, the Supplemental Examiner's Answer provides only conclusory statements that the framework pivots and, therefore, must inherently function in a manner identical to the apparatus claimed by Appellants.

In the end, this rejection also fails to meet the requirements set for every anticipation rejection based on inherency, i.e., "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *M.P.E.P.* § 2112, p. 2100-57, 8<sup>th</sup> Ed., Rev. 3, (August 2005) (emphasis in original) (citing *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In view of all of the above, Appellants submit that the Office has not met its burden in establishing anticipation based on inherency of claims 1, 5, 8-10, 12, 18, 21-22, and 25 by



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Kuroda et al. Review and reversal of this rejection by the Board are, therefore, respectfully requested.

**C. Claim 24 is patentable over French Patent Publication No. 2643847 to Apollonio et al. under 35 U.S.C. § 103(a).**

Appellants positions with respect to this rejection have been set forth previously in both the Appeal Brief filed August 28, 2003 and the Reply Brief filed November 26, 2003. This Reply Brief addresses the rejection as further discussed in the Supplemental Examiner's Answer.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Appellants submit that claim 24 is not *prima facie* obvious because, at a minimum, Apollonio et al. does not teach or suggest all of the elements of claim 24 (which depends from independent claim 22). As discussed above with respect to the anticipation rejection of claim 22 based on Apollonio et al., the cited reference does not teach all of the limitations of independent claim 22. It is further submitted that Apollonio et al. fails to even suggest the missing elements.

Appellants further submit that no suggestion or motivation has been identified in support of this obviousness rejection that would lead one of ordinary skill in the art to modify the apparatus of Apollonio et al. to reach the invention of claim 22 and, thus, claim 24. Moreover, claim 24 recites additional features that further define the patentability of the invention recited in claim 22.

For these reasons, Appellants respectfully request review and reversal by the Board of the rejection of claim 24 as obvious in view of Apollonio et al.

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**D. Claim 23 is patentable over French Patent Publication No. 2643847 to Apollonio et al. in view of U.S. Patent No. 5,891,297 to Stadtmueller under 35 U.S.C. § 103(a).**

This is a new ground of rejection set forth in the Supplemental Examiner's Answer. Appellants respectfully request review and reversal of this rejection by the Board for the reasons set forth below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Appellants submit that claim 23 is not *prima facie* obvious because, at a minimum, Apollonio et al. or Apollonio et al. in view of Stadtmueller do not teach or suggest all of the elements of claim 23 (which depends from independent claim 22). As discussed above with respect to the anticipation rejection of claim 22, Apollonio et al. does not teach all of the limitations of independent claim 22. It is further submitted that Apollonio et al. fails to suggest the missing elements. Nor does Stadtmueller remedy the deficiencies of Apollonio et al. – it being noted that Stadtmueller is cited only for its disclosure related to conformable rollers.

Appellants further submit that no suggestion or motivation has been identified in support of this obviousness rejection that would lead one of ordinary skill in the art to modify the apparatus of Apollonio et al. to reach the invention of claim 22 and, thus, claim 23.

For these reasons, Appellants respectfully request review and reversal by the Board of the rejection of claim 23 as obvious over Apollonio et al. in view of Stadtmueller.

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**IV. SUMMARY**

It is respectfully submitted that all of pending claims 1, 4-13, and 17-25 are patentable. It is earnestly requested that the Board reverse the Examiner's rejections of claims 1, 4, 5, 8-13, 17, 18, and 21-25, and that all of the claims be allowed.

Respectfully submitted

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By: Name: Rachel Gagliardi-Gebhardt